

### REMARKS

Claims 1-22 are pending while Claims 1 and 12 have been amended . Thus, Claims 1-22 remain presented for examination. The amendments to Claims 1 and 12 are supported by the specification and drawings, for example, at paragraph 0051-0052, Figures 3 (Step 330) and Figure 4 (Steps 402 and 406). No new matter is added by the amendments as discussed below. Applicant respectfully requests the entry of the amendments and reconsideration of the application.

#### Discussion of Rejection Under 35 U.S.C. § 112

Claims 1-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contended that the “input module” and “processing module” of Claim 1 do not functionally relate to each other. The Examiner further contends that the method of Claim 12 corresponds to and contains similar deficiencies as the system recited in Claim 1. Applicant respectfully disagrees.

However, solely to advance prosecution, Applicant has amended Claims 1 and 12 as discussed in the telephonic interview and reflected above. For this reason, Applicant respectfully requests withdrawal of this rejection.

#### Discussion of Rejection Under 35 U.S.C. § 103

The Examiner rejected Claims 1-22 under 35 U.S.C. § 103 (a) as being unpatentable over Gindlesperger (U.S. Patent No. 6,397,197) in view of Cupps (U.S. Patent No. 6,553,347). Applicant respectfully disagrees.

#### Claimed Invention

Independent Claim 1 is directed to an online system for ordering vehicle services. The system comprises an input module, a processing module, a transmission module and an estimation module. The input module is adapted to receive a service request order from a customer. The service request order comprises information indicative of the customer's geographical location. The processing module is adapted to determine a plurality of service businesses that are geographically near the customer based on the information indicative of the customer's geographical location. The transmission module is adapted to electronically transmit

the service request order to the plurality of service businesses. The estimation module adapted to receive service estimates from the plurality of service businesses.

Independent Claim 12 is directed to a method for electronically ordering vehicle services. The method comprises receiving a service request order from a customer; determining a plurality of service businesses; electronically transmitting the service request order to the plurality of service businesses; and receiving service estimates from the plurality of service businesses. The service request comprises information indicative of the customer's geographical location. The plurality of services are geographically near the customer's location and determined based on the information indicative of the customer's geographical location.

#### Disclosure of Gindlesperger and Cupps

Gindlesperger discloses a system and method for selecting a printing vendor that bids the lowest price for a print product/service. See Column 4, line 55-67. In Gindlesperger's system, a buyer provides an initial vendor pool to a central database server (Print ProSys<sup>SM</sup> server). See Gindlesperger at Column 4, lines 59-60. The initial vendor pool is a list of printing vendors that the buyer would like to do business with. See Column 4, lines 60-61. After the vendor network is established, the buyer sends an invitation-for-bid to the Print ProSys server in order to obtain a bid price from the vendors on their vendor list. See Column 5, lines 1-4.

From the invitation, the Print ProSys server determines which vendors have the capability to meet the bid.. See Column 5, lines 4-10. The Print ProSys server then compares and correlates the vendor selection criteria data to the vendor capability data of each vendor belonging to the buyer's vendor pool. See Column 5, lines 11-14. The Print ProSys server forwards the buyer's invitation-for-bid to each vendor whose vendor capability data satisfies the vendor selection criteria data. See Column 5, lines 14-18. If and when the Print ProSys server receives a plurality of responding bids, the Print ProSys server selects the lowest bid price and inform the buyer of which vendor is selected. See Column 5, lines 18-27. As the Examiner notes in the Office Action at page 4, the first full paragraph, Gindlesperger fails to teach determining a plurality of service businesses that are geographically near the customer.

Cupps discloses an online ordering machine for a product or service (food) over the Internet. The online ordering machine provides customers with product information from various vendors

Appl. No. : 09/736,670  
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whose delivery range covers the customer's location. The machine also provides product information from vendors having take-out services within a specified range from the customer's location. The machine allows a customer to search for vendors servicing the customer's location. Cupps is relied on to provide the deficiencies of Gindlesperger.

Gindlesperger and Cupps Do Not Establish a *Prima facie* Case of Obviousness

Under 35 U.S.C. § 103 the Examiner has the burden to establish a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants argue that the Examiner has not met this burden.

Gindlesperger fails to teach "determining a plurality of service businesses that are geographically near the customer." Cupps teaches selecting vendors that provide food take-out or delivery service near the customer's location. However, there is no proper motivation to combine these references. The examiner asserts a motivation to combine Gindlesperger and Cupps exists in that the customer is more likely to purchase services from the merchants geographically near them since they are more familiar with such merchants. Applicant respectfully submits that the Examiner's assertion is flawed and would not have motivated one of ordinary skill in the art to combine the references at the time of the claimed invention was made. More specifically, one of ordinary skill in the art would be discouraged from combining the references because the combination would add no benefits, and in fact may even destroy, the existing benefits of the Gindlesperger system. For this reason, there is no motivation to combine the teachings of Gindlesperger and Cupps.

In Gindlesperger, when the buyer makes an invitation-for-bid to the system the server selects vendors that can satisfy criteria drawn from the invitation-for-bid and forwards the invitation-for-bid to the selected vendors. These criteria relate to vendor's manufacturing capabilities, not to geographical location. If the teaching of Cupps is applied to the Gindlesperger system, the system would further select vendors who are located near the buyer in addition to the selection based on the criteria drawn from the invitation-for-bid. However, this would defeat the purpose of Gindlesperger's system, which allows the buyer to preselect the vendors they want to do business with, whether or not these vendors are located geographically near or remote from the buyer.

If all of the vendors initially chosen by the buyer are located geographically close to the buyer, a further selection for vendors located near the buyer is nonsensical because it would add no additional advantage, but would take computer resources. If all of the vendors initially chosen by the buyer are located geographically remote from the buyer, a selection for geographically close vendors also makes no sense because the buyer has already decided that he wishes to do business by geographically diverse vendors. As such, a further selection of vendors based on their geographical location adds no additional benefits, and may even destroy the existing benefit of the Gindlesperger system. Thus, one of ordinary skill in the art would not be motivated to combine Gindlesperger and Cupps. In addition such a combination would not have a reasonable expectation of success because combining Cupps into Gindlesperger defeats the predetermined vendor selection process taught by Gindlesperger.

During the interview, the Examiner maintained that Cupps demonstrates that buyers may desire to purchase products from local merchants. However, the Examiner's rejection is based on modifying the system of Gindlesperger to add the location determination step from Cupps which does not teach or suggest all of the claim limitations. In this combined situation, the buyer determines and selects vendors who are geographically close before making an invitation-for-bid or a service request order. In contrast, in Claim 1, a processing module, not the buyer or customer, is adapted to determine a plurality of service businesses that are geographically near the customer. Further, both in Claims 1 and 12, a plurality of service businesses is determined based on the information contained in the service request order, and therefore determining is necessarily on or after the service request order is made. As such, the combination of the

Appl. No. : 09/736,670  
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references do not provide all of the claim limitations. Thus, the Examiner has failed to establish a *prima facie* case of obviousness against Claim 1 or 12.

In view of the foregoing, Applicant asserts that Claims 1 and 12, and their related dependent claims are patentable over Gindlesperger and Cupps. For all of the above reasons, Applicant respectfully requests withdrawal of this rejection.

### CONCLUSION

In view of Applicant's amendments to the claims and the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Should the Examiner have any remaining concerns, which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

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